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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

COLEMAN, BRENDA LIBBY

ART UNIT PAPER NUMBER

1624

DATE MAILED: 07/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/073,326

Applicant(s)

OHTSUKA ET AL.

Examiner

Brenda Coleman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-36 is/are pending in the application.
- 4a) Of the above claim(s) 22-30 and 33-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-21, 31 and 32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/509,494.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claims 19-36 are pending in the application.

Election/Restrictions

1. Applicant's election of Group I in the reply filed on April 30, 2004 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

2. Claims 22-30 and 33-36 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on April 30, 2004.

Priority

3. An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification or in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)). The specific reference to any prior nonprovisional application must include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number.

Information Disclosure Statement

4. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be

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incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Specification

5. Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

6. Claims 19-21, 31 and 32 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:

- a) Claim 19 is vague and indefinite in that it is not known what is meant by the definition of Q, which is defined as group (i) as defined in claim 1 (see line 3).
- b) Claim 19 is vague and indefinite in that it is not known what is meant by the definition of R^2 to R^5 , R^{31} , R^{32} and R^{52} , which are as defined above (see lines 3-4). However, the definition of R^2 to R^5 , R^{31} , R^{32} and R^{52} are not defined within the claim.
- c) Claim 19 is vague and indefinite in that it is not known what is meant by the moiety NO_2 in formula (V). It is believed that the applicants intended NO_2 not N0_2 , i.e. zero vs. the letter O (see line 6)
- d) Claim 19 is vague and indefinite in that it is not known what is meant by the definition of R^2 to R^5 and R^{52} , which are as defined above (see line 7).
- e) Claim 19 is vague and indefinite in that it is not known what is meant by the definition of R^{31} and R^{32} , which are as defined above in claim 1 (see line 8).
- f) Claim 19 is vague and indefinite in that it is not known what is meant by the definition of R^{33} , which is as defined in claim 1 (see line 13).
- g) Claim 20 is vague and indefinite in that it is not known what is meant by the definition of Q, which is defined as group (i) as defined in claim 1 (see line 3).
- h) Claim 20 is vague and indefinite in that it is not known what is meant by the definition of R^2 to R^5 , R^{31} , R^{32} and R^{52} , which are as defined above (see lines 3-4).

However, the definition of R^2 to R^5 , R^{31} , R^{32} and R^{52} are not defined within the claim.

- i) Claim 20 is vague and indefinite in that it is not known what is meant by the moiety NO_2 in formula (V). It is believed that the applicants intended NO_2 not $N0_2$, i.e. zero vs. the letter O (see line 6)
- j) Claim 20 is vague and indefinite in that it is not known what is meant by the definition of R^2 to R^5 and R^{52} , which are as defined above (see line 7).
- k) Claim 20 is vague and indefinite in that it is not known what is meant by the definition of R^{31} and R^{32} , which are as defined above in claim 1 (see line 8).
- l) Claim 20 is vague and indefinite in that it is not known what is meant by the definition of R^{33} , which is as defined in claim 1 (see line 10).
- m) Claim 21 is vague and indefinite in that it is not known what is meant by the definition of Q, which is defined as group (i) as defined in claim 1 (see line 3).
- n) Claim 21 is vague and indefinite in that it is not known what is meant by the definition of R^2 to R^5 , R^{31} , R^{32} and R^{52} , which are as defined above (see lines 3-4). However, the definition of R^2 to R^5 , R^{31} , R^{32} and R^{52} are not defined within the claim.
- o) Claim 21 is vague and indefinite in that it is not known what is meant by the moiety NO_2 in formula (V). It is believed that the applicants intended NO_2 not $N0_2$, i.e. zero vs. the letter O (see line 6)
- p) Claim 21 is vague and indefinite in that it is not known what is meant by the definition of R^2 to R^5 and R^{52} , which are as defined above (see line 7).

- q) Claim 21 is vague and indefinite in that it is not known what is meant by the definition of Q, which is defined as group (i) as defined in claim 1 (see line 10).
- r) Claim 21 is vague and indefinite in that it is not known what is meant by the definition of R^{31} and R^{32} , which are as defined above in claim 1 (see line 11).
- s) Claim 31 is vague and indefinite in that it is not known what is meant by the definition of R^2 , R^3 , R^4 and R^5 where R^2 , R^3 , R^4 and R^5 is an optionally protected hydroxyl group.
- t) Claim 31 is vague and indefinite in that it is not known what is meant by the definition of R^2 , R^3 , R^4 and R^5 where R^2 , R^3 , R^4 and R^5 is (i) where the repeater m is not a subscript.
- u) Claim 31 is vague and indefinite in that it is not known what is meant by the definition of R^2 , R^3 , R^4 and R^5 where R^2 , R^3 , R^4 and R^5 is (j) where the repeater k is not a subscript.
- v) Claim 31 is vague and indefinite in that it is not known what is meant by the definition of R^2 , R^3 , R^4 and R^5 where R^2 , R^3 , R^4 and R^5 is (k) where the repeater j is not a subscript.
- w) Claim 31 is vague and indefinite in that it is not known what is meant by the definition of R^2 , R^3 , R^4 and R^5 where R^2 , R^3 , R^4 and R^5 is (l) where the repeater p is not a subscript.
- x) Claim 31 is vague and indefinite in that it is not known what is meant by the definition of R^2 , R^3 , R^4 and R^5 where R^2 , R^3 , R^4 and R^5 is (m) where the repeater q is not a subscript.

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y) Claim 31 is vague and indefinite in that it is not known what is meant by the definition of R^{52} where R^{52} is a protective group for carboxyl.

z) Claim 32 is vague and indefinite in that it is not known what is meant by the definition of R^2 , R^3 , R^4 and R^5 where R^2 , R^3 , R^4 and R^5 is an optionally protected hydroxyl group.

aa) Claim 32 is vague and indefinite in that it is not known what is meant by the definition of R^2 , R^3 , R^4 and R^5 where R^2 , R^3 , R^4 and R^5 is (i) where the repeater m is not a subscript.

ab) Claim 32 is vague and indefinite in that it is not known what is meant by the definition of R^2 , R^3 , R^4 and R^5 where R^2 , R^3 , R^4 and R^5 is (j) where the repeater k is not a subscript.

ac) Claim 32 is vague and indefinite in that it is not known what is meant by the definition of R^2 , R^3 , R^4 and R^5 where R^2 , R^3 , R^4 and R^5 is (k) where the repeater j is not a subscript.

ad) Claim 32 is vague and indefinite in that it is not known what is meant by the definition of R^2 , R^3 , R^4 and R^5 where R^2 , R^3 , R^4 and R^5 is (l) where the repeater p is not a subscript.

ae) Claim 32 is vague and indefinite in that it is not known what is meant by the definition of R^2 , R^3 , R^4 and R^5 where R^2 , R^3 , R^4 and R^5 is (m) where the repeater q is not a subscript.

af) Claim 32 is vague and indefinite in that it is not known what is meant by the definition of R^{52} where R^{52} is a protective group for carboxyl.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Coleman whose telephone number is 571-272-0665. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 571-272-0674. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Brenda Coleman
Primary Examiner Art Unit 1624
July 1, 2004